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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

k35a0882

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on 04/04/2008

Signature

Typed or printed name Howard H. Sheerin

Application Number

10/035,763

Filed

12/21/2001

First Named Inventor

L. Jeffrey Kapner III

Art Unit

2623

Examiner

Newlin, Timothy R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.  
☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

- ☐ attorney or agent of record.  
Registration number \_\_\_\_\_

- ☒ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 37,938

Signature

Howard H. Sheerin

Typed or printed name

303-765-1689

Telephone number

04/04/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

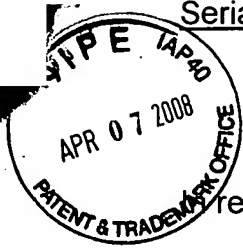
☐ \*Total of \_\_\_\_\_ forms are submitted.

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Art Unit 2623  
Serial No. 10/035,763

Reply to Office Action of: February 5, 2008  
Attorney Docket No.: K35A0882



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Pre Appln. of: L. Jeffrey Kapner III

Serial No.: 10/035,763

Filing Date: 12/21/2001

For: SYSTEM AND METHOD FOR  
SELECTING A PAY PER VIEW PROGRAM  
TO BE TRANSMITTED TO A PROGRAM  
RECEIVER

Art Unit: 2623

Examiner: Newlin, T. R.

Confirmation No.: 3826

Docket No.: K35A0882

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir,

In response to the office action mailed on February 05, 2008, please consider the following pre-appeal brief request for review. A Notice of Appeal has been filed herewith.

SUMMARY OF CLAIMED SUBJECT MATTER

FIG. 2 show a method of selecting a pay per view program to be transmitted to a program receiver, the method comprising:

(Step 100) obtaining a schedule of pay per view programs at the program receiver, each of the pay per view programs having a title and a plurality of transmission times;

(Step 102) generating a menu comprising the titles of at least one pay per view program, based on the schedule;

(Step 104) providing the menu to a display device for display to a user;

(Step 106) receiving from the user a selection by title of the pay per view program from the menu to be received by the program receiver;

(Step 108) the program receiver determining a potential transmission time of the pay per view program to be received by the program receiver based on the plurality of transmission times in the schedule of pay per view programs;

(Step 110) determining at the program receiver if an availability status of a content delivery path is available at a predetermined time prior to the potential transmission time;

(Step 112) if the availability status of the content delivery path is available at the predetermined time prior to the potential transmission time, (Step 114) requesting transmission of the pay per view program at the potential transmission time on the associated transmission channel; and

(Step 112) if the availability status of the content delivery path is not available at the predetermined time prior to the potential transmission time, repeating Steps 108-112 until the availability status of the content delivery path is available.

GROUND OF REJECTION TO BE REVIEWED

Claims 1, 5, and 7-10 stand rejected under 35 USC §103(a) as unpatentable over Schlarb (US 2004/0078823) in view of Mendelsohn (US 6,771,886) and further in view of Haddad (US 6,072,982). Claims 3 and 4 stand rejected under 35 USC §103(a) as unpatentable over Schlarb (US 2004/0078823) in view of Mendelsohn (US 6,771,886) and further in view of Ellis (US 2005/0235323). Claim 6 stands rejected under 35 USC §103(a) as unpatentable over Schlarb (US 2004/0078823) in view of Mendelsohn (US 6,771,886) and further in view of Haddad (US 6,072,982) and Yoshinobu (US 5,699,104). Claims 18-21 stand rejected under 35 USC §103(a) as unpatentable over Russo (US 6,025,868) in view of Shah-Nazaroff (US 6,157,377) and further in view of Mendelsohn (US 6,771,886).

ARGUMENT

I. THE ISSUE UNDER 35 U.S.C. §103(a)

- A. The rejections should be withdrawn because the relied upon prior art provides no reason for a program receiver to determine if a content delivery path is available at a predetermined time prior to a potential transmission time

Regarding claim 1, Haddad teaches a *program provider* determining if an availability status of a content delivery path is available. In particular, Haddad teaches that “when trying to insert the program segment into the schedule, [the program provider] checks for conflict with other program segments for the same customer at the same time, and if there is a conflict, inserts at the latest possible time when there is no conflict” (col. 10, lines 8-13). Thus if the combination of Schlarb and Mendelsohn were modified in view of Haddad it would not result in the claimed invention.

In response to this argument, the examiner asserts that Haddad merely describes a particular embodiment (at col. 10, lines 8-13) and “[w]hether the steps of Figs. 6 and 7 are performed at the receiver or the provider is not essential.” The examiner also asserts that Haddad “describes the steps while conspicuously omitting

any reference to which system component performs the steps." The applicant respectfully disagrees.

Haddad explicitly describes that the steps of Figs. 6 and 7 are to be performed by a program provider. In particular, at col. 4, lines 44-47 and 52-54, Haddad describes how the distribution center 100 "performs the following major functions:

1. Processes the incoming request for a video program from a customer... and
2. Schedules the video program segments for transmission and determine whether an incoming order can be delivered at the requested variable time allowance interval."

From this description, there is no question that Haddad describes a program provider (distribution center 100) performing the steps of Figs. 6 and 7.

In addition, the examiner is incorrect in asserting "[w]hether the steps of Figs. 6 and 7 are performed at the receiver or the provider is not essential." Performing the steps at the program receiver as opposed to the program provider has significant advantages. For example, it reduces the burden on the program provider to monitor the program selection activity of every customer, as well as it reduces the amount of network data transmitted between the program receiver and program provider. Haddad teaches explicitly that the availability status be determined at the program provider and provides no reason or suggestion for the program receiver to determine the availability status. The examiner is engaging in improper hindsight since "[o]nly in light of Applicant's own disclosed teaching would such a method become apparent to one skilled in the art of patent drafting; however, Applicant's disclosure cannot be used as prior art against his own claims." (In re Stencel 828 F.2d 751; 4 U.S.P.Q.2D (BNA) 1071 (1987)). The rejection should therefore be withdrawn.

CONCLUSION

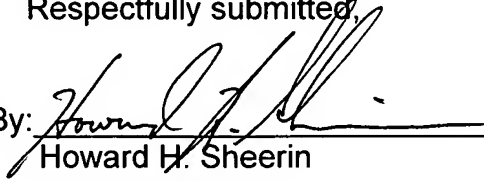
Withdrawal of the rejections is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 23-1209, and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: 4/4/08

By:

  
Howard H. Sheerin  
Reg. No. 37,938

WESTERN DIGITAL TECHNOLOGIES, INC.  
20511 Lake Forest Drive  
Lake Forest, CA 92630  
Tel.: (949) 672-7000  
Fax: (949) 672-6604

CERTIFICATE OF MAILING

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